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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,253	01/31/2000	Osamu Yamada	44239-066	3198

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EXAMINER	
TRAN, DOUGLAS Q	

ART UNIT	PAPER NUMBER
2624	5

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/494,253	YAMADA ET AL.
	Examiner	Art Unit
	Douglas Q. Tran	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 9-15 and 17 is/are allowed.

6)☒ Claim(s) 1-8 and 16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 1/31/00 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 8 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Chapman et al. (US Patent No. 6,522,421 B2).

As to claim 1, Chapman teaches an image formation apparatus (i.e., a printer, 15 or 15' or 15'' in figure 1, having a marking engine for forming hard copy output of the information from the various sources "col. 2, lines 42-50 and 55-56") comprising:

an input unit entering image data (col. 2, lines 42-43 and col. 3, lines 33-34: the printer receives the files from the printer server. The printer inherently comprises a component corresponding to an input unit for entering the document files from an input device such as the printer server. The document files are representative of image data formats such as TIFF, JPEG or GIF "col. 2, lines 47-49");

a printer unit (i.e., a marking engine) printing out image data (col. 2, lines 49-50 describes that the marking engine provides hard copy output of the information input from the various sources and col. 2, lines 55-56: the marking engine may record images on plain paper or plastic);

a detector detecting (i.e., box 47 in fig. 2) additional information from said image data (col. 3, lines 20-23 describes that additional information, which is the information embedded in the image data, includes the controlling conditions such as a finishing feature, copy sheets... for printing) said additional information including destination information (col. 3, lines 14-20 describes that email information, which is the second information embedded in the image data, includes an email address that is destination information).

(It is noted that, col. 3, lines 34-35, the printer detects additional information embedded in the image data including the embedded email information. With respect to box 47 in fig. 2, the printer inherently comprises a component corresponding to a detector for detecting the embedded additional information including the embedded email information that is destination information).

a transmission controller transmitting (i.e., box 49 in fig. 2) print information (i.e., a message) related to printing of said image data to said detected destination (col. 3, lines 40-47 describes that the information is mailed to the extracted email addresses. The message "or printing information" related to printing of the image data such as finishing options, pages printed, job completion "col. 3, lines 45-47" ; and it is noted that, with respect to box 49 in fig. 2, the printer inherently comprises a component corresponding to a transmission controller for sending the printing information to the extracted email address that is the detected destination).

As to claim 2, Chapman discloses every feature discussed in claim 1, and Chapman further teaches that said print information includes information indicating an event of printing out said image data (col. 3, lines 45-47 describes that the message is sent to the destination including print information that indicates an event of printing out the image data such as pages printed).

As to claim 3, Chapman discloses every feature discussed in claim 1, and Chapman further teaches that the print information includes a print condition to print out the image data (col. 3, lines 45-47 describes that the message is sent to the destination including print information that includes a print condition to print out the image data such as finishing options requested).

As to claim 5, Chapman discloses every feature discussed in claim 1, and Chapman further teaches that the additional information includes a print condition, the printer unit printing out the image data according to the print condition (col. 3, lines 20-23 describes that the additional information embedded in the image data includes a print condition such as staple, or select different medias).

As to claim 8, Chapman discloses every feature discussed in claim 1, and Chapman further teaches that the destination information is an electronic mail address (col. 3, lines 14-20 describes that email information embedded in the image data comprises an email address), the transmission controller transmitting print information to a destination specified by the electronic mail address through electronic mail (col. 3, lines 40-47) (it is noted that, with respect to box 49 in fig. 2, the printer inherently comprises a component corresponding to a transmission controller

for sending the printing information to the extracted email address that is the detected destination).

As to claim 16, Chapman teaches an image recording apparatus (i.e., a printer, 15 or 15' or 15'' in figure 1, having a marking engine for recording hard copy output of the information from the various sources "col. 2, lines 42-50 and 55-56") comprising:

an input unit entering image data (col. 2, lines 42-43 and col. 3, lines 33-34 describes that the printer receives the files from the printer server. The printer inherently comprises a component corresponding to an input unit for entering the document files from an input device such as the printer server. The document files are representative of image data formats such as TIFF, JPEG or GIF "col. 2, lines 47-49");

a recording unit (i.e., a marking engine) recording image data on a recording medium (col. 2, lines 49-50 describes that the marking engine provides hard copy output of the information input from the various sources and col. 2, lines 55-56: the marking engine for recording images on plain paper or plastic);

a detector (i.e., box 47 in fig. 2) detecting additional information from said image data (col. 3, lines 20-23 describes that additional information, which is the information embedded in the image data, includes the controlling conditions such as finishing feature, copy sheets... for printing) said additional information including destination information (col. 3, lines 14-20 describes that email information, which is second information embedded in the image data, includes an email address that is destination information).

(It is noted that, col. 3, lines 34-35, the printer detects additional information embedded in the image data including the embedded email information. With respect to box 47 in fig. 2, the

printer inherently comprises a component corresponding to a detector for detecting the embedded additional information including the embedded email information that is destination information).

a transmission controller (i.e., box 49 in fig. 2) transmitting recording information (i.e., a message) related to recording of said image data to said detected destination (col. 3, lines 40-47: the information is mailed to the extracted email addresses. The message "or printing information" related to printing of the image data such as finishing options, pages printed, job completion "col. 3, lines 45-47"; and it is noted that, with respect to box 49 in fig. 2, the printer inherently comprises a component corresponding to a transmission controller for sending the printing information to the extracted email address that is the detected destination).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Chapman as applied to claim 1 above, in combination with Ikenoue et al. (US Patent No. 5,671,277).

As to claim 4, Chapman discloses every feature discussed in claim 1.

However, Chapman does not teach the print condition includes the number of prints.

Ikenoue, in the same field of endeavor "image processor", teaches the print condition from the addition information includes the number of prints (col. 9, lines 16-24 describes that the print condition from the additional data embedded in the image data includes the number of copies of the document "col. 9, lines 23-24").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the print condition from the addition information of Chapman for including the number of prints as taught by Ikenoue. The suggestion for modifying the print condition of Chapman can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because the modified printing system of Chapman would increase the flexibility by adding more optional operation such as the number of prints to printing condition on the additional information. The printing system of Chapman processes the printing conditions faster when the printer detects a plurality of the printing conditions in the same format on the additional data embedded in the image data.

As to claim 6, Chapman discloses every feature discussed in claim 1.

However, Chapman does not teach the additional information includes inhibition information of printing, wherein a print operation by the printer unit is inhibited when the inhibition information is detected.

Ikenoue, in the same field of endeavor "image processor", teaches that the additional information includes inhibition information (i.e., secret information) of printing, wherein a print operation by the printer unit is inhibited when the inhibition information is detected (col. 9, lines 16-24 describes that the additional data embedded in the document image includes a secret

information; and the secret management section 20 decides the inhibition of copying according to the additional data "col. 10, lines 13-16").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the additional information of Chapman for including secret information (i.e., inhibition information) so that the print operation for that document is inhibited as taught by Ikenoue. The suggestion for modifying the additional information of Chapman can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because the modified printing system of Chapman would increase the functionality and the efficiency by inhibiting printout the confidential image document when detecting the inhibition information on the additional information from that image document. In resultant systems, the confidential image data stored in the printer is prevented and printed out by the authorized user at the printer.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Chapman as applied to claim 1 above, in combination with Mahoney et al. (US Patent No. 5,659,639).

As to claim 7, Chapman discloses every feature discussed in claim 1, and Chapman further teaches an image processing unit (i.e., RIP in fig. 1) in the printer to process image data (col. 2, lines 30-33 describes that a raster image processor "RIP" for processing the original image data in a form of document description language from input devices "col. 2, lines 20-26" by converting the document; it is noted that: col. 3, lines 38-40 further describes that the image data in a form of the page description file is interpreted until completion and it is marked or printed on the media in which the selected media is printing condition from additional information embedded in the image data "col. 3, lines 20-22"); and additional information

including printing conditions (col. 3, lines 20-22) and transmission condition (col. 3, lines 14-17).

However, Chapman does not teach the image processing unit to process image data based on an image processing condition from the additional information.

Mahoney, in the same field of endeavor "image processor", teaches additional information includes an image processing condition for process the image data (col. 12, lines 20-22 describes that the input image data defining an input image set shows graphical feature and editing marks indicating an editing operation to be performed on the graphical feature. The editing marks would be representative of the image processing condition because the input image data or the graphical feature is processed based on the editing operation) by the image processing unit (i.e., the processor 66 "in fig. 3"; It is noted that, with respect to col. 12, lines 61-65 describes that processor 66 receives the image data defining an input image set including editing marks indicating editing operation to be performed on the graphical feature of the image data; and then the processor 66 obtains and uses the editing operation to process the image data into the final output image data "col. 12, line 65 to col. 13, line 6").

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the additional information of Chapman to include the image processing condition for processing the image data as taught by Mahoney and the image processing unit of Chapman to process the image data based on the image processing condition as taught by Mahoney. The suggestion for modifying the system of Chapman can be reasoned by one of ordinary skill in the art as set forth above by Mahoney because the modified printing system of Chapman would increase the flexibility by adding more optional condition such as the

image processing condition to the additional information; and the printing system of Chapman would increase the efficiency by detecting the printing conditions and the image processing condition in the same format on the additional data embedded in the image data so that the image processing unit of the printer performs image processing at the same time with the performance of printing conditions by other units in the printer.

Allowable Subject Matter

7. Claims 9-15 and 17 are allowed.

Claims 9 and 17 are independent claims.

The following is an examiner's statement of reasons for allowance:

As to claim 9, the present invention discloses the additional information from the image data, which is stored in the memory, includes trigger information to initiate execution of a control operation including transmission operation corresponding to the trigger information; and a controller executes the control operation including the transmission operation after the trigger information is detected. The closest prior art such as Ikenoue (US Patent No. 5,671,277) discloses the additional data useful for the management of copies of a document for an image forming apparatus is embedded in a hard copy of the document; and Chapman (US Patent No. 6,522,421) discloses transmission operation such as email information from the image data that is executed after the print job is completed. However, Chapman and Ikenoue, either singularly or in combination, fail to teach the above underlined limitations of the present invention.

As to claim 17, the present invention discloses the additional information from the image data includes trigger information to initiate execution of a predetermined control operation

including transmission operation corresponding to the trigger information; and a controller executes the predetermined control operation including the transmission operation after the trigger information is detected. The closest prior art such as Ikenoue (US Patent No. 5,671,277) discloses the additional data useful for the management of copies of a document for an image forming apparatus is embedded in a hard copy of the document; and Chapman (US Patent No. 6,522,421) discloses transmission operation such as email information from the image data that is executed after the print job is completed. However, Chapman and Ikenoue, either singularly or in combination, fail to teach the above underlined limitations of the present invention.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Apr. 04, 2003